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**RESPONSE UNDER 37 CFR 1.116**  
**EXPEDITED PROCEDURE**  
**EXAMINING GROUP 3641**

**Fax Transmission**

**From:** Mitchell R. Swartz, MD, ScD  
Call (781) 237-3625  
or 239-1779 fax  
(please call first)

**To:** **Examiner Rick J. Palabrica**      Group Art Unit: 3641  
Examiner Palabrica  
  
Group Art Unit: 3641

**Address:** **BOX AF**  
The Commissioner of Patents and  
Trademarks  
Washington, D.C. 20231

FAX  
703 872-9306

**AFTER FINAL**

**Date:** **RESPONSE UNDER 37 CFR 1.116**  
**EXPEDITED PROCEDURE**  
**EXAMINING GROUP 3641**

**Time:** **Pages: 3**  
**Part - pages**

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Re: Serial no. 09/750, 480

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**URGENT**

62. The Examiner states,

*"As presently set forth, the electrical power system (box 50 in Fig. 1), the optical irradiator subsystem (box 30 in Fig. 1), the optical detection subsystem (box 31 in Fig. 1), the central control unit (box 23 in Fig. 1) and the power source (box 42 in Fig. 1) are essentially "black boxes" with no description of the internals thereof. Applicant has not shown where the specifics of the internals of the "black boxes" are described in the cited publications)."*

**The Truth - The Examiner Has Been Substantively Unresponsive, This Was Discussed Previously**

The Examiner has been unresponsive to Applicant's arguments even though they were fully discussed in significant detail in the previous Communication from the Applicant to the Examiner. For example, in said Communication, the Applicant took the time to respond to the Examiner and wrote the following comment.

**"The original specification was clear and sufficient for the affiants, and the previous Examiner Wasil, and the court. As the specification states, "The optical beam originates from an optical laser contained in an optical irradiator subsystem (labeled as number 30) and is detected electrooptically by an optical detection subsystem (labeled as number 31). The photodetector and associated equipment are not shown in this figure. The repetitive cutoff of the optical beam occurs due to the physical displacement of the cathode during an oscillation as described herein. These oscillations may occur during the loading of said cathode, or may occur periodically. The mass of the cathode (increasing by adsorption of deuterons) increases antecedent to the desired reactions, and results in a decreasing of the frequency of said oscillation (vide infra). The mass is derived from the decrease in oscillation frequency."**

**[from Applicant's previous Communication to the Examiner]**

In fact, as the present Application states, and was discussed in the previous Communication to the Examiner which was ignored,

**"Figure 1 is a simplified three-dimensional diagram of the reaction monitoring system, showing an electrochemically loading system ("reaction system") containing the vibrating cathode, and accompanied by the optical monitoring system and the orthogonal magnetic pumping coil.**

**Within the reaction chamber (labeled as number 16) is the platinum anode (labeled a number 60), and the palladium cathode (labeled as number 1). These electrodes are driven by an external electrical power system (labeled as number 50).**

**The cathode (labeled as number 1) has a variety of positions of which three are shown. These displacements are greatly magnified in Figure 1. For simplicity the reactor (16) is filled to the top. ... When this novel cathode does move, it interferes with an optical beam (labeled as number 12 in Figure 1)."**

**Thus, the original specification teaches (page 4, line 32 through page 5, line 3), the best mode contemplated by the inventor of carrying out his invention using an optical subsystem (referring to the figures).**

**"The optical beam originates from an optical laser contained in an optical irradiator subsystem (labeled as number 30) and is detected**

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electrooptically by a optical detection subsystem (labeled as number 31)."

The original specification teaches (page 5, lines 5-8) and elaborates for those skilled in the art to make and use the subject matter defined by each of the rejected claims.

"The repetitive cut-off of the optical beam occurs due to the physical displacement of the cathode during an oscillation as described herein. These oscillations may occur during the loading of said cathode, or may occur periodically."

The original specification (page 5, lines 8-12), continues with the teaching of how the vibrational frequency relates to the loading.

"The mass of the fusion cathode (increasing by adsorption of deuterons) increases antecedent to nuclear fusion, and results in a decreasing of the frequency of said oscillation (vide infra). The mass is derived from the decrease in oscillation frequency.

The original specification teaches (page 5, lines 13-18), the best mode contemplated by the inventor of carrying out his invention using detected vibration of the loaded electrode (referring to the figures).

"The frequency information is collected, and all the subunits are driven, by a central control unit (labeled as number 23). Said control unit also powers the means to drive said vibrational frequency, consisting of a power source (labeled as number 42) and a coil (labeled as number 41, of which only a few turns are shown in Figure 1) .... "

"Because the natural frequency can be counted with a laser beam and photodetector (coupled to a trigger and frequency counter), an accurate in situ determination of frequency is possible."

The original specification continues (page 5, lines 23-25) with the teaching of the determination.

"The cathode can be modeled as a pendulum, and any analysis is simplified by considering that most of the mass resides in the large terminal portion of said cathode (labeled as number 1). The analysis can be derived from Newton's Law, from the viscous damping force, and the approximation that the cathode behaves similar to a basic mass/spring-type system."

[from Applicant's previous Communication to the Examiner]

Attention is now directed to the fact that said comments in Applicant's Communication have simply been ignored by the Examiner. The Commissioner, and Court, should note that the Examiner did not cite Applicant's arguments, nor did the Examiner discuss Applicant's arguments, nor did the Examiner rebut Applicant's arguments. Therefore it is impossible to tell how the Examiner weighed Applicant's arguments; there is absolutely no way for the Applicant to present the Examiner's reasons for rejection to the Board of Appeals. Because the Examiner was requested to answer and respond with specificity, the Examiner has apparently ignored the Office rules, and expectations of reasonable people, and has defied the laws and regulations arising from the US Constitution which led to the creation of the Patent

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Office. The Applicant hereby requests to know the substantive precise reason, scientific basis, or authority which allows the Examiner to dismiss this Argument by the Applicant without citation, analysis, or substantive coherent response.

Nonetheless, to further respond and hopefully please the examiner, the Applicant does now submit an amendment, which if the Examiner will enter, will satisfy the Examiner's request.

63. The Examiner states,

*"There is neither an adequate description not enabling disclosure of the parameters of a specific operative embodiment of the invention, including ...required magnetic strength of coil 41, distance between the coil and the coil ... (Applicants arguments in his traverse have been fully considered but found unconvincing. Applicant has not incorporated by reference the applications that allegedly contain the above subject matter)."*

**THE TRUTH - The Examiner Has Been Substantively Unresponsive,  
This was Discussed Previously**

The Examiner has been unresponsive to Applicant's arguments even though they were fully discussed in significant detail in the previous Communication from the Applicant to the Examiner. For example, in said Communication, the Applicant took the time to respond to the Examiner and wrote the following comment which are well known to those skill in the art,

**"This is well known to those skilled-in-the-art as the Declarants indicate. The Examiner is referred to the literature such as "The Physical Principles of Magnetism", Allan H. Morrish, John Wiley and Sons, New York, 1966, and the Amateur Radio Handbook, which will explain this further for the Examiner.**

[from Applicant's previous Communication to the Examiner]

Attention is now directed to the fact that said comments in Applicant's Communication have simply been ignored by the Examiner. Therefore it is impossible to tell how the Examiner weighed Applicant's arguments; there is absolutely no way for the Applicant to present the Examiner's reasons for rejection to the Board of Appeals.

Nonetheless, to further respond and hopefully please the examiner, the Applicant does now submit an amendment, which if the Examiner will enter, will satisfy the Examiner's request.

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64. Ignored in the Examiner's Communication are the following standards of review which have been cited by the Applicant. The Applicant explicitly requested answers with specificity regarding each of the Office's systematic deviations. There has been no substantive response. Ignored by the Examiner is the following argument by the Applicant citing *In re Hogan*,

**"The Examiner ignores *In re Hogan* [559 F.2d 595, 60S, 194 USPQ 527, 537 (CCPA 1977)] which discusses that enablement must be judged on the original specification and claims, but in the Office Communication it was not.**

[from Applicant's previous Communication to the Examiner]

Attention is now directed to the fact that said comments in Applicant's Communication have simply been ignored by the Examiner. Therefore it is impossible to tell how the Examiner weighed Applicant's arguments; there is absolutely no way for the Applicant to present the Examiner's reasons for rejection to the Board of Appeals. The Applicant hereby again requests to know the substantive precise reason, scientific basis, or authority which allows the Examiner to dismiss this Argument by the Applicant without citation, analysis, or substantive coherent response.

65. Also ignored by the Examiner is the following argument by the Applicant citing following argument by the Applicant citing *In re Fouche*,

**"The Examiner ignores *In re Fouche* [439 F.2d 1237, 1243, 169 USPQ 429, 434, (CCPA 1971) and *In re Zletz* [893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989)] which state that an invention (in structure, operation and composition) is defined by the claims and the original specification.**

[from Applicant's previous Communication to the Examiner]

Attention is now directed to the fact that said comments in Applicant's Communication have simply been ignored by the Examiner. Therefore it is impossible to tell how the Examiner weighed Applicant's arguments; there is absolutely no way for the Applicant to present the Examiner's reasons for rejection to the Board of Appeals. The Applicant hereby again requests to know the substantive precise reason, scientific basis, or authority which allows the Examiner to dismiss this Argument by the Applicant without citation, analysis, or substantive coherent response.

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66. Also ignored by the Examiner is the following argument by the Applicant citing *In re Morris*,

**"The Examiner ignores *In re Morris* which requires that the Examiner must respond to what Applicant meant, but he did not.**

[from Applicant's previous Communication to the Examiner]

Attention is now directed to the fact that said comments in Applicant's Communication have simply been ignored by the Examiner. Therefore it is impossible to tell how the Examiner weighed Applicant's arguments; there is absolutely no way for the Applicant to present the Examiner's reasons for rejection to the Board of Appeals. The Applicant hereby again requests to know the substantive precise reason, scientific basis, or authority which allows the Examiner to dismiss this Argument by the Applicant without citation, analysis, or substantive coherent response.

67. Also ignored by the Examiner is the following argument by the Applicant citing *In re Prater*,

**"The Examiner ignores *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969)] which requires the Examiner to refer to the claimed invention as the focus of its Office communication, but it did not when drifting toward criticism of "FP".**

[from Applicant's previous Communication to the Examiner]

Attention is now directed to the fact that said comments in Applicant's Communication have simply been ignored by the Examiner. Therefore it is impossible to tell how the Examiner weighed Applicant's arguments; there is absolutely no way for the Applicant to present the Examiner's reasons for rejection to the Board of Appeals. The Applicant hereby again requests to know the substantive precise reason, scientific basis, or authority which allows the Examiner to dismiss this Argument by the Applicant without citation, analysis, or substantive coherent response.

68. Also ignored by the Examiner is the following argument by the Applicant citing Rule 132,

**"The Examiner ignores Rule 132 which requires Applicant's solid, substantial, and timely, evidence submitted against the Examiner's rejections be considered because "(p)atentability is determined on the totality of the record, by a preponderance of the evidence with due consideration to persuasiveness of argument." [Id. at 1445, 24 USPQ2d at 1444]. Applicant has published his inventions, proving that this invention was correctly taught in the original specification and claims, on the filing date of the application.**

**[from Applicant's previous Communication to the Examiner]**

Attention is now directed to the fact that said comments in Applicant's Communication have simply been ignored by the Examiner. Therefore it is impossible to tell how the Examiner weighed Applicant's arguments; there is absolutely no way for the Applicant to present the Examiner's reasons for rejection to the Board of Appeals. The Applicant hereby again requests to know the substantive precise reason, scientific basis, or authority which allows the Examiner to dismiss this Argument by the Applicant without citation, analysis, or substantive coherent response.

69. Also ignored by the Examiner is the following argument by the Applicant citing *In re Gazave*,

**"The Examiner ignores *In re Gazave*, 54 CCPA 1524, 379 F.2d 973, 154 USPQ 92 (1967)] and *In re Chilowsky* [43 CCPA 775, 229 F.2d 457, 108 USPQ 321 (1956)] which require consideration of the material which Applicant supplied and cited - and now has supplied again.**

**[from Applicant's previous Communication to the Examiner]**

Attention is now directed to the fact that said comments in Applicant's Communication have simply been ignored by the Examiner. Therefore it is impossible to tell how the Examiner weighed Applicant's arguments; there is absolutely no way for the Applicant to present the Examiner's reasons for rejection to the Board of Appeals. The Applicant hereby again requests to know the substantive precise reason, scientific basis, or authority which allows the Examiner to dismiss this Argument by the Applicant without citation, analysis, or substantive coherent response.

70. Also ignored by the Examiner is the following argument by the Applicant citing *In re Brana* and *In re Eltgroth*,

**"The Examiner ignores *In re Brana* and *In re Eltgroth*, 419 F.2d 918, 164 USPO 221 (CCPA 1970) which demand that the Examiner must establish a reason to doubt an invention's asserted utility, and the method to reveal information about the loading, *in situ*, and non-invasively using a vibrating electrode, composed of a metal such as palladium which has internal filling ("loading") with hydrogen, which is monitored for its natural frequency, as was presented in the original specification and claims has great utility. It is not 'incredible' or 'unbelievable' like the Examiner appears to purport. This invention is quite believable.**

[from Applicant's previous Communication to the Examiner]

Attention is now directed to the fact that said comments in Applicant's Communication have simply been ignored by the Examiner. Therefore it is impossible to tell how the Examiner weighed Applicant's arguments; there is absolutely no way for the Applicant to present the Examiner's reasons for rejection to the Board of Appeals. The Applicant hereby again requests to know the substantive precise reason, scientific basis, or authority which allows the Examiner to dismiss this Argument by the Applicant without citation, analysis, or substantive coherent response.

71. Also ignored by the Examiner is the following argument by the Applicant submitted evidence including Declarations and published peer-reviewed scientific articles ,

**"108. In summary, Examiner must consider the submitted evidence including:**

- #1) Declarations from scientists of ordinary skill-in-the-art, who considered the specification and stated that the written description was sufficient.**
- #2) The published peer-reviewed scientific articles [including m Swartz, M., "Possible Deuterium Production From Light water excess enthalpy experiments using Nickel Cathodes", *Journal of New Energy*, 3, 68-80 (1996) and Swartz, 1998, Improved Electrolytic Reactor Performance Using  $\pi$ -Notch System Operation and Gold Anodes, Transactions of the American Nuclear Association, Nashville, Tenn 1998 Meeting, (ISSN:0003-018X publisher LaGrange, Ill) 78, 84-85 and Swartz(92, 94A, 97A, 97C)].**

[from Applicant's previous Communication to the Examiner]

Attention is now directed to the fact that said comments in Applicant's Communication have simply been ignored by the Examiner. Therefore it is impossible to tell how the Examiner weighed Applicant's arguments; there is absolutely no way for the Applicant to present the Examiner's reasons for rejection



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to the Board of Appeals. The Applicant hereby again requests to know the substantive precise reason, scientific basis, or authority which allows the Examiner to dismiss this Argument by the Applicant without citation, analysis, or substantive coherent response.

72. Also ignored by the Examiner is the following argument by the Applicant citing *In re Wands*,

**"The Examiner ignores *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) which indicates that #1 or #2 are sufficient to demonstrate that the specification provides an adequately written description of the subject matter, including how to operate the invention, and claimed the invention so that an artisan, or those skilled-in-the-art, could practice it without undue experimentation. Either #1 or #2 prove that enablement, utility, and validation. Together, #1 and #2 have been submitted and Applicant submits that these together corroborate enablement of the present invention both *de facto* and *de jure*.**

[from Applicant's previous Communication to the Examiner]

Attention is now directed to the fact that said comments in Applicant's Communication have simply been ignored by the Examiner. Therefore it is impossible to tell how the Examiner weighed Applicant's arguments; there is absolutely no way for the Applicant to present the Examiner's reasons for rejection to the Board of Appeals. The Applicant hereby again requests to know the substantive precise reason, scientific basis, or authority which allows the Examiner to dismiss this Argument by the Applicant without citation, analysis, or substantive coherent response.

73. Also ignored by the Examiner is the following argument by the Applicant citing *In re Vaeck*,

**"The Examiner ignores *In re Vaeck* [947 F.2d 488, 495-96, 10 USPQ2d 1438, 1444 (Fed. Cir. 1991)] which states that an enablement rejection under section 112, ¶1 is only appropriate where the written description fails to teach those skilled-in-the-art, like the Declarants, to make and use the invention.**

[from Applicant's previous Communication to the Examiner]

Attention is now directed to the fact that said comments in Applicant's Communication have simply been ignored by the Examiner. Therefore it is impossible to tell how the Examiner weighed Applicant's arguments; there is absolutely no way for the Applicant to present the Examiner's reasons for rejection to the Board of Appeals. The Applicant hereby again requests to know the substantive precise reason, scientific basis, or authority which allows the Examiner

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to dismiss this Argument by the Applicant without citation, analysis, or substantive coherent response.

74. Also ignored by the Examiner is the following argument by the Applicant citing Clause 8 of Section 8, Article I,

**"The Examiner has ignored controlling authorities including Clause 8 of Section 8, Article I, by improperly eliminating an entire field involving energy and United States security.**

[from Applicant's previous Communication to the Examiner]

Attention is now directed to the fact that said comments in Applicant's Communication have simply been ignored by the Examiner. Therefore it is impossible to tell how the Examiner weighed Applicant's arguments; there is absolutely no way for the Applicant to present the Examiner's reasons for rejection to the Board of Appeals. The Applicant hereby again requests to know the substantive precise reason, scientific basis, or authority which allows the Examiner to dismiss this Argument by the Applicant without citation, analysis, or substantive coherent response.

75. Also ignored by the Examiner is the following argument by the Applicant citing Article VI,

**"The Examiner has ignored controlling authorities including Article VI, by interfering with laws passed by Congress [DIAMOND v. CHAKRABARTY; 447 U.S. 303, 309] including that patentable statutory subject matter spans "anything under the sun that is made by man" [S. Rep. No. 1979, 82d Cong., 2d Sess., 5 (1952); H. R. Rep. No. 1923, 82d Cong., 2d Sess., 6 (1952)].**

[from Applicant's previous Communication to the Examiner]

Attention is now directed to the fact that said comments in Applicant's Communication have simply been ignored by the Examiner. Therefore it is impossible to tell how the Examiner weighed Applicant's arguments; there is absolutely no way for the Applicant to present the Examiner's reasons for rejection to the Board of Appeals. The Applicant hereby again requests to know the substantive precise reason, scientific basis, or authority which allows the Examiner to dismiss this Argument by the Applicant without citation, analysis, or substantive coherent response.

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76. Also ignored by the Examiner is the following argument by the Applicant citing Article I, Section 2,

**"The Examiner has ignored controlling authorities including Article I, Section 2, by ignoring that Applicant is entitled to the privileges and immunities of citizens in the other states. Specifically, the Examiner ignores that the Office, Europe and Japan have allowed selected other patents in the very same field not allowed here [Czirr(5,231,290), Westphal(5,215,631), Ahern(5,411,654), Patterson(5,036,031), (5,318,675), (5,372,688), (5,036,031); Aspden, UK-GB 2,231,195B]. This is a dual-tiered system which the Office has set up to usurp constitution rights of the Applicant and American citizens.**

**[from Applicant's previous Communication to the Examiner]**

Attention is now directed to the fact that said comments in Applicant's Communication have simply been ignored by the Examiner. Therefore it is impossible to tell how the Examiner weighed Applicant's arguments; there is absolutely no way for the Applicant to present the Examiner's reasons for rejection to the Board of Appeals. The Applicant hereby again requests to know the substantive precise reason, scientific basis, or authority which allows the Examiner to dismiss this Argument by the Applicant without citation, analysis, or substantive coherent response.

77. Also ignored by the Examiner is the following argument by the Applicant citing Supreme Court in United States v. Nixon (1974),

**"110. The Examiner continues to have two different standards of review. Therefore, the Examiner has ignored controlling authorities including the reasoning of the Supreme Court in United States v. Nixon (1974) that all are "equal under the law". Hence, the Examiner has ignored controlling authorities including the 14th Amendment, requiring an impartial tribunal [28 U.S. Code Section 144, Mayberry v. Penna., 91 S.8.; Bloom v. Illinois, 88 Ct. 499 S.Ct. 1477; Duncan v. Louisiana, 88 S.Ct.1444] and equal protection. In the light of the previously unrebutted Declarations [hereby again submitted] there appear to be violations of the 14th Amendment's "equal protection" clause [Frontiero v. Richardson, 93 S.Ct. 1736, 411 U.S. 677; Weiss v. Weiss, 436 N.Y.S. 2d. 862, 52 N.Y. 2d. 170 (1981)] with serious implications [Gass v. Lopez, 95 S. Ct 729; Wood v. Strickland, 95 S Ct 9S2; U.S. v. Price, 86 S Ct 1152, 1157, Footnote 7; Griffin v. Breckenridge, 91 S Ct 179D; Gamez v. Toledo, 42 U.S.C.§1983, and Bivens v. Six Unknown Named Agents of Fed. Bureau of Narcotics]."**

**..[from Applicant's previous Communication to the Examiner]**

Attention is now directed to the fact that said comments in Applicant's Communication have simply been ignored by the Examiner. Therefore it is impossible to tell how the Examiner weighed Applicant's arguments; there is

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absolutely no way for the Applicant to present the Examiner's reasons for rejection to the Board of Appeals. The Applicant hereby again requests to know the substantive precise reason, scientific basis, or authority which allows the Examiner to dismiss this Argument by the Applicant without citation, analysis, or substantive coherent response.

78. The Examiner purports that Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph because the claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art ... to make and/or use the Invention. This is not true.

As proven above, the Applicant taught the subject matter defined by each of the rejected Claims including how his apparatus and method works, set forth the best mode contemplated, distinctly pointed out and claimed the subject matter which constitutes the invention, wrote an adequate enabling disclosure, and thus complied and conformed with 35U.S.C. §112, first paragraph, of the Patent Act.

In accordance with the foregoing arguments that Applicant has conformed with the requirements of sections 112 of the Patent Act, and reversal of the rejection of the Claims 1-20, and allowance of Claims 1-20 is respectfully requested, as required by the statute (35 USC 112).

## DISCUSSION OF 35 USC 101 REJECTION

79. The Examiner states,

*"5. Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention as disclosed is inoperative and therefore lacks utility. The reasons that the inventions as disclosed is inoperative are the same as the reasons set forth in sections 3 and 4 above and the reasons set forth in sections 3 and 4 above are accordingly incorporated herein."*

### **THE TRUTH - The Examiner Has Been Substantively Unresponsive, This was Discussed Previously**

The Examiner is wrong for several reasons. First, the citations are wrong. Second, the citations made by the examiner are themselves void of reason, precision and substance, as discussed above. Third, the examiner remains substantively unresponsive to Applicant's arguments even though they were fully discussed in significant detail in the previous Communication from the Applicant to the Examiner on pages 91 through 100. For example, in said Communication, the Applicant took the time to respond to the Examiner and wrote the following comments and questions.

To begin, the citations are wrong, and are void of reason. The Examiner refers to #4, but #4 states that "Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention". This is false as discussed above. The Examiner also refers to #3, but #3 states that "Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the (invention)." This, too, is false as discussed above.

Even more importantly, the Examiner has been unresponsive to Applicant's arguments even though they were fully discussed in significant detail in the previous Communication from the Applicant to the Examiner on pages 91 through 100. For example, in said Communication, the Applicant took the time to respond to the Examiner and wrote the following comments and questions.

**"... the Examiner must consider those skilled-in-the-art who oppose and counter the rejection under 35U.S.C.§101. Third, the Examiner points to out art not involving this Application. However, validation occurs when scientists actually skilled, and working, in the state-of-the-art state it to be so. These are scientists who research and actually write the current scientific technical papers which undergo peer-review, file patent applications, and attend international conferences (which have gone on for thirteen years). They absolutely disagree with the Examiner on this. Fourth, and most importantly, there is reputable evidence of record to indicate the invention has been reduced to the point of providing an operative cold fusion. system. Fifth, the Claims clearly define subject**

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**matter of considerable utility because energy needs dominate, and are critical to the economy."**

[from Applicant's previous Communication to the Examiner]

Attention is now directed to the fact that said arguments in Applicant's Communication have simply been ignored by the Examiner. Therefore it is impossible to tell how the Examiner weighed Applicant's arguments; there is absolutely no way for the Applicant to present the Examiner's reasons for rejection to the Board of Appeals. Therefore, given the above, the Applicant hereby requests to know the substantive precise reason, scientific basis, or authority which allows the Examiner to dismiss this Argument by the Applicant without citation, analysis, or substantive coherent response.

80. The Examiner has been unresponsive to Applicant's arguments citing [M.P.E.P. §2111.01],

**"Utility is a fact question, and proof of utility is sufficient if it meets at least one stated objective. In this case, it does. The Examiner has not followed the Office's own standards of review. The Office's rule [M.P.E.P. §2111.01] requires that**

**"the words of a claim ... must be read as they would be interpreted by those of ordinary skill in the art".**

**Utility is a fact question, and proof of utility is sufficient if it is convincing to one of ordinary skill in the art or if it meets at least one stated objective.**

**"Utility is a fact question, see e.g., Wilden Pump v. Pressed & Welded Products Co, 655 F.2d 984, 988, 213 USPQ 282, 285 (9th Cir. 1981); Nickola v. Peterson, 580 F.2d 898, 911, 198 USPQ 385, 399 (6th Cir. 1978), cert. denied, 440 U.S. 961, 99 S.Ct. 1504, 59 L.Ed.2d 774 (1979)."**

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**"When a properly claimed invention meets at least one stated objective, utility under 101 is clearly shown. See e.g., Standard Oil Co. (Indiana) v. Montedison, S.P.A., 664 F.2d 356, 375, 212 USPQ 327, 344 (3rd Cir. 1981), cert. denied, 456 U.S. 915, 102 S.Ct. 1769, 72 L.Ed.2d 174 (1982); E.I. du Pont de Nemours & Co. v. Berkley & Co., 620 F.2d 1247, 1258 n. 10, 1260 n. 17, 205 USPQ 1, 8 n. 10, 10 n. 17 (8th Cir.1980); Krantz and Croix v. Olin, 148 USPQ 659, 661-62 (CCPA 1966); Chisum on Patents, 4.04[4] [1983]."**

**[RAYTHEON COMPANY v. ROPER CORPORATION, U.S.C.A., Federal Circuit, 1983, 724 F.2d 951, 220 USPQ 592]]**

[from Applicant's previous Communication to the Examiner]

Attention is now directed to the relevance of the *Amicus Curiae* Brief of Drs. Edmund Storms [Exhibit "10", 2/21/01], *Amicus Curiae* Brief of Hal Fox [Exhibit "18", 5/8/02], *Amicus Curiae* Brief of Eugene Mallove [Exhibit "20", 5/8/02 ],

Declaration of Scott Chubb [Exhibit "15", 8/13/01], Declaration of Hal Fox [Exhibit "16", 5/16/95], Declaration of Mr. Rotegard [Exhibit "13", 5/15/94], Declaration of Hal Fox [Exhibit "17", 8/14/01], Declaration of Eugene Mallove [Exhibit "19", 5/6/94], and Straus Declaration of [Exhibit "9", 5/22/94] have been ignored even though the affidavits have probative value and even though the averments prove utility of the present invention. Applicant's Communication have simply been ignored by the Examiner. Because it is impossible to tell how the Examiner weighed Applicant's arguments, and because there is absolutely no way for the Applicant to present the Examiner's reasons for rejection to the Board of Appeals, the Applicant hereby requests to know the substantive precise reason, scientific basis, or authority which allows the Examiner to dismiss this Argument by the Applicant without citation, analysis, or substantive coherent response.

81. The Examiner has been unresponsive to Applicant's arguments citing In Re Jolles,

"Proof of utility is sufficient if it is convincing to one of ordinary skill in the art. In re Irons, 52 CCPA 938, 340 F.2d 974, 144 USPQ 351 (1965). The amount of evidence required depends on the facts of each individual case. In re Gazave, 54 CCPA 1524, 379 F.2d 973, 154 USPQ 92 (1967). The character and amount of evidence needed may vary, depending on whether the alleged utility appears to accord with or to contravene established scientific principles and beliefs. In re Chilowsky, 43 CCPA 775, 229 F.2d 457, 108 USPQ 321 (1956)." [In Re Jolles, U.S.C.P.A., 1980. 628 F.2d 1322, 206 USPQ 885]

"The Declarations demonstrate that the original specification and claims clearly define subject matter of considerable utility. Therefore, the Applicant has fully conformed with, and satisfied, the requirements of §101 of the Patent Act and met at least one (1) stated objective [Standard Oil Co. (Indiana) v. Montedison, S.P.A., 664 F.2d 356, 375, 212 USPQ 327, 344 (3rd Cir. 1981), cert. denied, 456 U.S. 915, 102 S.Ct. 1769, 72 L.Ed.2d 174 (1982); E.I. du Pont de Nemours & Co. v. Berkley & Co., 620 F.2d 1247, 1258 n.10, 1260 n.17, 205 USPQ 1,8n10,10n.17(8th Cir.1980); Krantz and Croix v. Olin, 148 USPQ 659, 661-62 (CCPA 1966); Chisum on Patents, 4.04[4] [1983]; RAYTHEON COMPANY v. ROPER CORPORATION, U.S.C.A., Federal Circuit, 1983, 724 F.2d 951, 220 USPQ 592]."

[from Applicant's previous Communication to the Examiner]

Attention is now directed to the fact that said arguments in Applicant's Communication have simply been ignored by the Examiner. Because it is impossible to tell how the Examiner weighed Applicant's arguments, and because there is absolutely no way for the Applicant to present the Examiner's reasons for rejection to the Board of Appeals, the Applicant hereby requests to know the substantive precise reason, scientific basis, or authority which allows the Examiner to dismiss

this Argument by the Applicant without citation, analysis, or substantive coherent response.

82. The Examiner has been unresponsive to Applicant's arguments citing *In re Zurko*,

The Examiner has rejected *In re Zurko* [142 F.3d 1447, 1449, 46 USPQ2d 1691, 1693 (Fed. Cir.), cert. granted, 119 S. Ct. 401 (1998)] which declares that utility is a fact question [RAYTHEON COMPANY v. ROPER CORPORATION, U.S.C.A., Federal Circuit, 1983, 724 F.2d 951, 220 USPQ 592], and one which the Examiner in this case must review for clear error [Cross v. Iizuka, 753 F.2d 1040, 1044 n.7, 224 USPQ 739, 742 n.7 (Fed. Cir. 1985); also *In re Zurko*].

116. The Examiner has rejected the directive of 1.131 (a)(1) which requires that

"When ... a patent ... is rejected .... on reference ... to a printed publication, the inventor of the subject matter of the rejected claim ... may submit an appropriate oath or declaration to overcome the patent or publication." Unrebutted Declarations have been submitted in this case, and are again submitted, and the Examiner must respond to them substantively [Marino v. Hyatt Corporation; Morrill v. Tong; and Chelebda v. H.E. Fortuna & Brothers Inc].

*In re Irons* indicates that utility is a fact question [RAYTHEON COMPANY v. ROPER CORPORATION]. The submitted Declarations and the publications (including e.g. McKubre) are relevant as proof of utility. They demonstrate utility and operability at the time of the filing of this patent, and that it was, and is, important and of considerable utility.

[from Applicant's previous Communication to the Examiner]

Attention is now directed to the fact that said arguments in Applicant's Communication have simply been ignored by the Examiner. Because it is impossible to tell how the Examiner weighed Applicant's arguments, and because there is absolutely no way for the Applicant to present the Examiner's reasons for rejection to the Board of Appeals, the Applicant hereby requests to know the substantive precise reason, scientific basis, or authority which allows the Examiner to dismiss this Argument by the Applicant without citation, analysis, or substantive coherent response.



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In summary, the Applicant hereby requests to know the scientific basis, or any basis, in the light of the Declarations which allows the Examiner to dismiss the Argument that,

**"Proof of utility is sufficient if it is convincing to one of ordinary skill in the art. "**

The Applicant also hereby requests to know the scientific basis, or any basis, in the light of the Declarations which allows the Examiner to dismiss the *Amicus Curiae* Brief of Talbot Chubb [Exhibit "14", 2/22/01], *Amicus Curiae* Brief of Drs. Edmund Storms [Exhibit "10", 2/21/01], Averment 4 in the *Amicus Curiae* Brief of Mr. Rotegard [Exhibit "12", 2/21/01], Pages 4 through 8 in *Amicus Curiae* Brief of Thomas Valone [Exhibit "11", 2/24/01], and pages 2-5 in the Straus Declaration [Exhibit "8", November 27, 1992] have been ignored even though the affiants have probative value and even though the averments prove operability of the present invention.

83. The Examiner has been unresponsive to Applicant's arguments citing *In re Ziegler*, *In re Ferens*, *Ex parte Porter*, *In re Morris*, *In re Oetiker*, *Ex parte Gray*, *In re Brana*, *In re Marzocchi* and *In re Oetiker*.

"The Examiner has rejected *In re Ziegler* [992 F.2d 1197, 1200, 26 USPQ2d 1600, 1603 (Fed. Cir. 1993)] which requires the Examiner accept Declarations as factual proof of utility.

The Examiner has rejected *Marino v. Hyatt Corporation*, 793 F.2d 427, 430 (1st Cir. 1986); *Morrill v. Tong*, 390 Mass. 1207 129 (1983); *Chelebda v. H.E. Fortuna & Brothers Inc* 609 F.2d 1022 (1st Cir. 1979); *Lewis v. Bours*, 119 Wn.2d 667, 670, 1992] which require the Examiner to assume that the Declarants' assertions are true.

The Examiner has rejected *In re Ferens* [417 F.2d 1072, 1074, 163 USPQ 609,611 (CCPA 1969)] which heralds that Applicant's submitted evidence, including Declarations, is sufficient.

The Examiner has rejected *Ex parte Porter* which requires that Declarations, submitted in response to the Examiner's comments, must be read, examined, and carefully considered.

The Examiner has rejected *In re Morris* [127 F.3d 1048, 1053-56, 44 USPQ2d 1023, 1027-30 (Fed. Cir. 1997)] which demands that the interpretation of operability and utility is predicated upon that which one who is skilled-in-the-art would reach. The Examiner must give the claims their broadest reasonable interpretation consistent with that which those skilled-in-the-art would reach.

The Examiner has rejected *In re Oetiker* [977 F.2d at 1445, 24 USPQ2d at 1444] which requires the Examiner substantively and fully respond to the probative witnesses, because Applicant has undertaken the full burden coming forward.

The Examiner has rejected *Ex parte Gray* [10 USPQ2d 1922, 1928 (Bd. Pat. App. & Inter. 1989)] which allows for Applicant's submitted expert testimony regarding operability and utility, beyond the detailed specification. The Examiner must give substantial weight to said Declarations about what they said about this invention compared to the Examiner's art regarding the work of others.

The Examiner has rejected *In re Brana*, 51 F.3d at 1566, 34 USPQ2d at 1441] which indicates Applicant's actions hereby meet the "burden shift ... to provide rebuttal evidence sufficient to convince such a person of the invention's asserted utility".

The Examiner has rejected *In re Marzocchi* and *In re Oetiker* which require responsive argument to the fully addressed criticism against the Examiner's unfounded notions. *In re Marzocchi*, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971)] declares that the Examiner cannot make the rejection he has unless he has reason to doubt the objective truth of the statements contained in the written description, here corroborated and supported by multiple Declarations. "

...[from Applicant's previous Communication to the Examiner]

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Attention is now directed to the fact that said comments in Applicant's Communication have simply been ignored by the Examiner. The Examiner did not cite Applicant's arguments, nor did the Examiner discuss Applicant's arguments, nor did the Examiner rebut Applicant's arguments. Therefore it is impossible to tell how the Examiner weighed Applicant's arguments; there is absolutely no way for the Applicant to present the Examiner's reasons for rejection to the Board of Appeals. The Examiner was requested to answer and respond with specificity, but has not shown due diligence. Therefore, given the above, the Applicant hereby again requests to know the substantive precise reason, scientific basis, or authority which allows the Examiner to dismiss this Argument by the Applicant without citation, analysis, or substantive coherent response.

**84. The Examiner has been unresponsive to Applicant's arguments citing Gottschalk v. Benson**

"Utility is a fact question, and proof of utility is sufficient if it meets at least one stated objective. Measurement and product formation involve transformation of a state or thing. Therefore, the Examiner has not followed the standards of review because such a two state method should be patentable based upon opinion of the Court.

"Transformation and reduction of an article "to a different state or thing" is the clue to the patentability of a process claim that does not include particular machines."

[GOTTSCHALK v. BENSON, 409 U.S. 63 (1972),  
409 U.S. 63, No. 71-485]

"Industrial processes such as this ["a physical and chemical process (which involves) the transformation of an article .... into a different state or thing"] are the types which have historically been eligible to receive the protection of our patent laws. [450 U.S. 175, 185]"

[DIAMOND v. DIEHR, 450 U.S. 175 (1981)]

[from Applicant's previous Communication to the Examiner]

Attention is now directed to the fact that said comments in Applicant's Communication have simply been ignored by the Examiner. Therefore it is impossible to tell how the Examiner weighed Applicant's arguments; there is absolutely no way for the Applicant to present the Examiner's reasons for rejection to the Board of Appeals. The Applicant hereby again requests to know the substantive precise reason, scientific basis, or authority which allows the Examiner to dismiss this Argument by the Applicant without citation, analysis, or substantive coherent response.

85. The Examiner has been unresponsive to Applicant's arguments citing Art. I, §8, cl. 8 and DIAMOND v. CHAKRABARTY, 447 U.S. 303, 309.

"The Examiner has rejected the controlling authority of Art. I, §8, cl. 8 which provides that "Congress shall have Power (t)o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries" Art. I, §8, cl. 8 empowers Congress in this matter. Yet, the Examiner has rejected that the US Congress has mandated progress. "The patent laws (reflect) this Nation's deep-seated .... need to encourage progress." [DIAMOND v. CHAKRABARTY, 447 U.S. 303 (1980), 447 U.S. 303, No. 79-136]

In the Office Communication [Exhibit "A"], the Examiner appears to have rejected that the US Congress has mandated encouragement of science, and the Office's actions are inconsistent both with the Patent Act of 1793, authored by Thomas Jefferson, which defined statutory subject matter as "any new and useful art, machine, manufacture, or composition of matter" Act of Feb. 21, 1793, 1, 1 Stat. 319, and with the Act which embodied Jefferson's philosophy that "ingenuity should receive a liberal encouragement." [447 U.S. 303, 309].

Therefore, because the Examiner appears to again ignore these matters, if in the future it becomes necessary to address compliance, standards of review, and recognition of receipt of said federal documents, applicant reserves the right to file a Complaint in federal court, including in the First Circuit, to address these cited matters involving said violations of the US Constitution and Office rules. Applicant submits these materials again, and hopes that this accountability matter will not be necessary. Applicant hopes that, instead, the Office will henceforth respect the accuracy of peer-reviewed publications [including those published by the American Nuclear Society, and the long detailed record in this and the associated applications, along with the urgent and critical need for this country's judicial economy and energy security, and the belief that the Patent Office is compliant with its standards of review and consistent with both said Constitution and aid Congressional directive.

[from Applicant's previous Communication to the Examiner]

Attention is now directed to the fact that said comments in Applicant's Communication have simply been ignored by the Examiner. Therefore it is impossible to tell how the Examiner weighed Applicant's arguments; there is absolutely no way for the Applicant to present the Examiner's reasons for rejection to the Board of Appeals.

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86. Attention is now directed to the fact that Applicant's Communication stated, "The Examiner improperly ignores and/or dismisses the Affiants' facts about the invention as "opinion". However, Declarants' statements and the peer-reviewed publications are Fact. The Applicant again asks the Office and Examiner (who refused to answer when asked on the telephone, as did his Supervisor): Exactly how many Declarants does it take to overcome the Examiner's unsubstantiated rejection? The answer is simple. The answer is quantitative. The answer is one (1). "

[from Applicant's previous Communication to the Examiner]

Attention is now directed to the fact that said comments in Applicant's Communication have simply been ignored by the Examiner. Therefore it is impossible to tell how the Examiner weighed Applicant's arguments; there is absolutely no way for the Applicant to present the Examiner's reasons for rejection to the Board of Appeals.

In summary, in this case, the Applicant has set forth products and methods which have undergone peer-review, and as such do present utility within the meaning of 35 U.S.C. 101 [Brenner v Manson, 148 U.S.P.Q. 689]. Therefore, in this case, utility under 101 is clearly shown. Given the utility Applicant respectfully requests reconsideration of the rejection of Claims 1-20 pursuant to U.S.C. 101.

## CONCLUSION

103. Applicant taught in the original specification and claims how his apparatus works and claimed the invention. Applicant has made a diligent effort to amend the claims of this application so that Claims 1-20 define a novel structure which is also submitted to render said claimed structure unobvious because it produces new and unexpected results. The Applicant has explained in detail (*supra*) how the cited art is different and therefore produces a different result from the present invention. Applicant has given lists of additional critical features and components which distinguish Applicant's invention to operatively function in a different manner to the cited art. Therefore, the Applicant submits that any combination of the other cited art is an improper one, absent any showing in the references themselves that they can or should be so combined. Neither of the references appears to suggest, or allude to, or teach a structure as defined by Claims 1-20. It appears that the figures and claims of the other cited art are intended to, and do, serve a different purpose than does the structure defined by the claims, and each of the cited art adds nothing of substance. None of the references shows a method to reveal information about the loading, *in situ*, and non-invasively using a vibrating electrode, composed of a metal such as palladium which has internal filling ("loading") with hydrogen, which is monitored for its natural frequency. None of the references shows these features. Therefore, based upon the facts cited here, these Claims 1-20 are patentable over the cited references because the claims recite novel structure and thus are distinguished physically over every reference [Sec. 102], with physical distinctions which effect new and unexpected results, thereby indicating that the physical distinction is simply not obvious [Sec. 103].

104. As the original specification and claims teach, the present invention solves the long-standing problem of monitoring loading, *in situ*, and non-invasively. The Examiner should admit that said features are not "incredible" but can be elicited when using the teachings of the original specification and claims. Furthermore, there is documented existence of these reactions and the preferred environment in which the present invention does operate, and of the operation of the present invention. Therefore, if the Examiner disagrees with overturning his improper rejection without foundation, then the Applicant requests specificity as to the reason to facilitate Appeal. Specifically, Applicant requests that Examiner makes clear in the record which of these submitted averments by the Declarants regarding operability and utility were formally and substantially considered, and if the Examiner disputes them, exactly how he will have reached his conclusion. Furthermore, if the Examiner continues to dismiss, ignore, or relegate the relevant Exhibits and Declarations discussed above, then the Applicant hereby explicitly requests an adequate explanation of how the Declarations failed to overcome the *prima facie* case initially established by the Examiner. If necessary, for the Board of Appeal, Applicant requests it be stated explicitly, with clear pointing to where in Applicant's publications or applications said rebuttal relates with specificity.

#### Request For Constructive Assistance

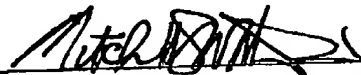
105. If, for any reason the claims of this application are not believed to be in full condition for allowance, the applicant respectfully requests the constructive assistance and suggestions of the Examiner in drafting one or more acceptable claims [pursuant to MPEP 707.07(j)] or in making constructive suggestions [pursuant to MPEP 706.03(d)] in order that this application can be placed in allowable condition as soon as possible and without the need for further proceedings.

106. Applicant respectfully notes that the U.S. Supreme Court has ruled that any pro se litigant is entitled to less stringent standards [U.S. Rep volume 404, pages 520-521 (72)].

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WHEREFORE for the above reasons, the Applicant respectfully requests reconsideration and that the hereby submitted claims for entry to comply with the Examiner's communication are entered. The claims now differ even more significantly from the cited art, and are even more clearly consistent with the original specification and claims. Hopefully this will satisfy the Examiner and there will be reversal of the Examiner's rejections of Claims 1-20 rejected under 35 U.S.C. 112, first paragraph, "as failing to comply with the enablement requirement", Claims 1-20 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, Claims 1, 3-7 rejected under 35 U.S.C. 102(b) as being anticipated by JP-06 018683, and Claims 8-20 rejected under 35 U.S.C. 103(a) as being unpatentable over JP 06-018683 in view of any one of Wang et al. (U.S. 5,495,767), Steinlecher et al. (U.S. 5,883,715) or Zang et al. (U.S. 5,838,439). Applicant requests this reversal as is just and reasonable, or requests that the Examiner address each matter of law and error of fact cited herein with the precision and accuracy expected of the those who operated under color of federal law.

Respectfully,

  
Mitchell R. Swartz, ScD, MD, EE**Certificate Of Mailing [37 CFR 1.8(a)]**

January 28, 2004

To Whom it Does Concern:

I hereby certify that this correspondence will be deposited with the United States Postal Service by First Class Mail, postage prepaid, in an envelope addressed to  
"Office of the Clerk  
Board Of Patent Appeals  
c/o The Commissioner for Patents  
Alexandria, VA 22313-1450" on the date below.

Thank you.

Sincerely,  
January 28, 2004

  
M.R. Swartz  
Weston, MA 02493